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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/736,430	12/15/2000	Jocelyn Cloutier	2685/113592	8766
23838	7590	03/29/2004		
KENYON & KENYON 1500 K STREET, N.W., SUITE 700 WASHINGTON, DC 20005			EXAMINER CONTEE, JOY KIMBERLY	
			ART UNIT	PAPER NUMBER
			2686	
			DATE MAILED: 03/29/2004	

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/736,430

**Applicant(s)**

CLOUTIER ET AL.

**Examiner**

Joy K Contee

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,8,9,11,12,16-19,22-24,26,27 and 29-36 is/are rejected.
- 7) ☒ Claim(s) 3,7,10,13-15,21,25,28,37 and 38 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Solomon, U.S. Patent No. 5,974,043.

Regarding claim 1, Solomon discloses a method for synchronously delivering complementary data to a first device and a second device, the method comprising:

receiving a command through a network for synchronous transmission of complementary data (i.e., exchanged digital information) (col. 19, lines 32-41); and transmitting first data through the network to the first device, the transmission of the first data (i.e., read on compressed or non-compressed voice information) synchronized with transmission of second data (i.e., read on compressed or non-compressed video information or data files) transmitted to a second device, the first and second data forming complementary data (col. 19, lines 31-41 and col. 21, lines 45-59).

Regarding claim 2, Solomon discloses the method of claim 1 wherein the network is a telephone network (col. 20, lines 45-51).

Regarding claim 4, Solomon discloses the method of claim 1 wherein the network is a wireless network (col. 20, lines 52-61).

Regarding claim 5, Solomon discloses the method of claim 1 wherein the network is a first network (i.e., reads on PSTN) and second data (i.e., reads on WAN call) is transmitted to the second device through a second network (i.e., reads on WAN telephone system) (col. 21, lines 21-29).

Regarding claim 6, Solomon discloses the method of claim 5 wherein the second network is a telephone network (i.e., WAN telephone system) (col. 21, lines 21-30).

Regarding claim 8, Solomon discloses the method of claim 5 wherein the second network is a wireless network (col. 20, lines 52-61).

Regarding claim 9, Solomon discloses the method of claim 5 wherein each of the first data and the second data is one from the group consisting of audio data and video data (col. 19, lines 31-41).

Regarding claim 11, Solomon discloses the method of claim 1 wherein the first device is a telephone (col. 20, lines 62-67).

Regarding claim 12, Solomon discloses a system for synchronously delivering complementary data through a network, the system comprising: a control unit; a first device connected to the control unit through the network; and a second device connected to the control unit through the network, wherein the control unit synchronously delivers complementary data to the first device and the second device (col. 20, lines 22-40, see Fig. 11).

Regarding claim 16, Solomon discloses a method for remotely controlling a telephone using a device connected to a network, the network being connected to a telephone network through a gateway server, the method comprising:

receiving a command to control a telephone from a device; and controlling the telephone in accordance with the command, wherein the receiving and controlling steps are executed at a location that is remote from the location of the device and the location of the telephone (col. 17, lines 30-42 and col. 18, lines 6-17).

Regarding claim 17, Solomon discloses the method of claim 16 wherein the functionality of the telephone is controlled after a communication channel between the telephone and another device has been established (col. 18, lines 30-40).

Regarding claim 18, Solomon discloses a method for remotely controlling an appliance connected to a first network using a device connected to a second network, the first network connected to the second network through a gateway server, the method comprising: receiving a command to control an appliance from a device; and controlling the appliance in accordance with the command, wherein the receiving and controlling steps are executed at a location that is remote from the location of the device and the location of the appliance (col. 17, lines 30-42 and col. 19, lines 6-17).

Regarding claim 19, Solomon discloses a method for delivering first data through a network for playback or display on a first device in synchronicity with playback or display of second data on a second device, the first data and the second data forming complementary data, the method comprising: receiving a command through a network for transmission of complementary data; and transmitting first data through the network

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to a first device for playback or display on the first device in synchronicity with playback or display of second data on a second device, wherein the first and second data form complementary data (col. 17, lines 30-42).

Regarding claim 20, Solomon discloses the method of claim 19 wherein the network is a telephone network (col. 17, lines 59-65)

Regarding claim 22, Solomon discloses the method of claim 19 wherein the network is a wireless network (col. 10, lines 12-24).

Regarding claim 23, Solomon discloses the method of claim 19 wherein the network is a first network and second data is transmitted to the second device through a second network (col. 15, lines 7-17).

Regarding claim 24, Solomon discloses the method of claim 23 wherein the second network is a telephone network (col. 17, lines 30-42).

Regarding claim 26, Solomon discloses the method of claim 24 wherein the second network is a wireless network (col. 10, lines 12-23).

Regarding claim 27, Solomon discloses the method of claim 24 wherein each of the first data and the second data is one from the group consisting of audio data and video data (col. 19, lines 32-42).

Regarding claim 29, Solomon discloses the method of claim 19 wherein the first device is a telephone (col. 20, lines 40-45).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 10, 28, 30-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Solomon, in view of Kim, U.S. Patent No. 6,317,425.

Regarding claims 10 and 28, Solomon discloses the method of claim 1 and 19 but fails to explicitly wherein the first device is a PDA.

In a similar field of endeavor, Kim discloses wherein the first device is a PDA (col. 2, lines 46-50).

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify Solomon to include a PDA as a portable telephone or computer for the purpose of adding another communication apparatus to the WAN telephone system.

Regarding claim 30, Solomon discloses a method for synchronously delivering complementary data to a first device and a second device, the method comprising:

receiving a command through a network for synchronous transmission of complementary data (i.e., exchanged digital information) (col. 19, lines 32-41); and

transmitting first data through the network to the first device, the transmission of the first data (i.e., read on compressed or non-compressed voice information) synchronized with transmission of second data (i.e., read on compressed or non-

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compressed video information or data files) transmitted to a second device, the first and second data forming complementary data (col. 19, lines 31-41 and col. 21, lines 45-59).

Solomon fails to explicitly disclose a PDA.

In a similar field of endeavor, Kim discloses wherein the first device is a PDA (col. 2, lines 46-50).

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify Solomon to include a PDA as a portable telephone or computer for the purpose of adding another communication apparatus to the WAN telephone system.

Regarding claim 31, Solomon as modified by Kim discloses the method of claim 30 wherein the first data is transmitted to the PDA and the second data is transmitted to a device (see Kim, col. 2, lines 46-50).

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify Solomon to include a PDA as a portable telephone or computer for the purpose of adding another communication apparatus to the WAN telephone system.

Regarding claim 32, Solomon as modified by Kim discloses the method of claim 30 wherein at least one of the first data and the second data is either unicast or multicast to a predetermined collection of users or devices (see Solomon, col. 21, lines 1-17).

Regarding claim 33, Solomon as modified by Kim discloses the method of claim 32 wherein the first data and second data are intended for observation by the same entity or person (col. 21, lines 9-17).



Regarding claim 34, Solomon as modified by Kim discloses the method of claim 33 wherein the first data is played on the PDA (see Kim, col. 6, lines 41-64).

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify Solomon to include a PDA as a portable telephone or computer for the purpose of adding another communication apparatus to the WAN telephone system.

Regarding claim 35, Solomon as modified by Kim discloses the method of claim 34 wherein the first data is textual data that is inherently displayed (i.e., for the purpose of allowing user to view message) on the PDA (col. 4, lines 24-59).

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify Solomon to include a PDA as a portable telephone or computer for the purpose of adding another communication apparatus to the WAN telephone system.

Regarding claim 36, Solomon as modified by Kim disclose the method of claim 34 wherein the first data is audio data (see Solomon, col. 19, lines 32-41).

***Allowable Subject Matter***

5. Claims 3,7,10,13-15,21,25,28 and 37-38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: Prior art of record fails to explicitly disclose in combination with the limitations of the independent claims, wherein the first network is the internet or wherein the first device is a vehicle navigation system and wherein the complementary data includes

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navigational video data delivered to the first device and supplementary data delivered to the second device wherein the first device is a video monitor and wherein the complementary data includes video data delivered to the first device and subtitles delivered to the second device.

***Conclusion***

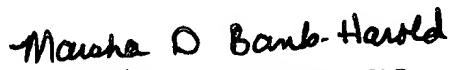
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joy K Contee whose telephone number is 703-308-0149. The examiner can normally be reached on 5:30 a.m. to 2:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on 703-305-4379. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

  
Joy Contee

March 21, 2004

  
MARSHA D. BANKS-HAROLD  
SUPERVISORY PATENT EXAMINER  
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